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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/688,813 | 10/20/2003 | Raja Tuli | | 2966 |

7590

01/26/2006

RAJA TULI
SUITE 1130
555 RENE LEVESQUE WEST
MONTREAL, QC H2Z 1B1
CANADA

EXAMINER

RESTIFO, JEFFREY J

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|----------------------------|--|
| Office Action Summary | Application No. 10/688,813 | Applicant(s) TULI, RAJA | |
| | Examiner Jeffrey J. Restifo | Art Unit 3618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 13-26, 29, 30, 68, 70, 73-81, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120 and 135 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8-12, 27, 28, 31, 123, 126, 129 and 132 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 32-67, 79-92, 94, 95, 97, 98, 100, 101, 103, 104, 106, 107, 109, 110, 112, 113, 115, 116, 118, 119, 121, 122, 124, 125, 127, 128, 130, 131, 133, 134, 136 and 137.

DETAILED ACTION

Election/Restrictions

1. Claims 32-67, 79-92, 94, 95, 97, 98, 100, 101, 103, 104, 106, 107, 109, 110, 112, 113, 115, 116, 118, 119, 121, 122, 124, 125, 127, 128, 130, 131, 133, 134, 136, and 137 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species B-D, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/19/05.

Applicant's election with traverse of species A in the reply filed on 10/19/05 is acknowledged. The traversal is on the ground(s) that the species are not patentably distinct. This is not found persuasive because the examiner believes the species are patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electric power storage means, motor, sensors, and computer must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-31, 68-78, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, and 135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 2, the phrase "normal mechanical action" is indefinite because a person's walking action can vary and is subjective to the persons style.

Claims 20-26, the limitations directed towards a "normal walking speed" are indefinite because the speed is subjective to each individual person.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamet et al. (US 5,236,058 A).

Yamet et al. discloses a pair of motorized skates comprising a mechanical assembly including wheels 18A, 20A, motor means 22, energy storage means or battery (not shown), and wireless remote 40 for controlling the speed of the skates simultaneously, as shown in figures 1-11.

Claims 1, 2, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, and 135 are rejected under 35 U.S.C. 102(b) as being anticipated by Staelin et al. (US 6,059,062 A).

Staelin et al. discloses a motorized skate comprising wheels 12A, batteries 33, motor 32, sensors 74 for sensing pressure and/or speed and computers for analyzing the results of said sensors and adjusting the speed of the skates, as shown in figures 1-6.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamet et al., as applied to claim 2 above, and further in view of Petrosino (US 5,882,018 A).

Yamet et al. does not disclose walls surrounding the assembly able to act as a support for the skates. Petrosino does disclose a slate 10 comprising mechanical means 32 for elevating the roller assembly 12 into a cavity formed by outer walls 33 able to support a user, as shown in figures 1-10. It would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the motorized skate of Yamet et al. with the retracting assembly with support walls of Petrosino in order to convert the skates into walking shoes.

9. Claims 6, 7, 13-26, 29, 30, 70, 73, and 74-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamet et al., as applied to claim 2 above, and further in view of Shyr et al. (US 5,730,241 A).

With respect to claims 6 and 7, Yamet et al. does not disclose a conveyor driven by the motor. Shyr et al. does disclose motorized skates 1 including conveyor 2, as shown in figure 1. It would have been obvious to one having ordinary skill in the art at

the time of the invention to have provided the motorized skate of Yamet et al. with the conveyor of Shyr et al. in order to increase surface traction.

With respect to claims 13-18, the use of shock absorbers along the length of skates is well known in the art and it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the skate of Yamet et al. as modified by Shyr et al. with shocks in order to dampen vibration.

With respect to claims 20-26, little patentable weight has been given to these claims because they rely on the notion a "normal walking speed", which is subjective and varies depending on the person.

With respect to claims 19, 29, and 30, the skates of Yamet et al. as modified by Shyr et al. would continue to work at a constant speed when lifted from the ground.

Allowable Subject Matter

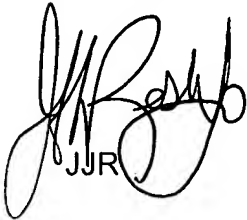
10. Claims 4, 5, 8-12, 27, 28, 31, 123, 126, 129, and 132 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey J. Restifo whose telephone number is (571)272-6697. The examiner can normally be reached on M-F 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571)272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JJR